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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,222	05/23/2005	Georg Gros	DNAG-292 (10112294)	2140
24972 7590 02/12/2008 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			EXAMINER CAMERON, ERMA C	
			ART UNIT 1792	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/511,222	Applicant(s) GROS, GEORG	
	Examiner /Erma Cameron/	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-65 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 26-65 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/13/2004, 12/9/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 26-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) The following has not been sufficiently defined and is therefore vague and indefinite:

Claim 26, line 2; claim 27, line 2; claim 58, line 2; claim 59, line 2; claim 60, line 2; claim 61, line 2; claim 62; claim 64	low-abrasive
Claim 26, line 6; claim 27, line 7	lacquer-like
Claim 26, line 11	steep
Claim 26, line 20; claim 27, line 23	small
Claim 26, line 20; claim 27, line 23	over-sized
Claim 26, line 22; claim 27, line 25	some
Claim 28, line 4; claim 43, line 4	higher
Claim 31, 34, 46, 49	soft, very soft
Claim 34 and 49	low intensity

Claim 35 and 50	similar
Claim 35 and 50	where
appropriate	
Claim 36 and 51	over-sized
Claim 36 and 51	narrower
Claim 37 and 52	excess
Claim 38 and 53	thoroughly
Claim 40 and 55	substantially
Claim 40 and 55	other
Claim 58 and 59, line 3 of each	thin
Claim 58 and 59, line 3 of each	another
Claim 58, line 7; claim 59, line 7; claim 60 line 12; claim 61, line 12	some
Claim 58, lines 9/10	severe
Claim 58, line 10	large
Claims 59-61	currently
conventional	
Claims 59 and 61	troublesome
Claims 59- 61	very difficult
Claim 58-61	some
Claim 63 and 65	sensitive

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b) Claim 26, line 7 and claim 27, line 8: it is not clear what “optionally” (second one) defines.

c) The phrases "such as", “e.g”, “preferably” and “in particular” render the following claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d):

claim 26-27, 31-32, 34, 39-41, 46-47, 49, 54-56

d) The following lack proper antecedent basis:

claim 26, line 11	these
claim 26, line 19	this
claim 27, line 12	the envelope curve
claim 27, line 12	the particle size distribution
claim 27, line 12	these
claim 27, line 21	these
claim 28, line 2; claim 43	the remaining inorganic particles
claim 28, line 5	the Gauss distribution curve
claim 28, line 6	the corresponding Gauss distribution curve
claim 29 and 44	film
claim 34	the very soft or soft particles
claim 36 and 51	grinding
claim 37 and 52	the curing agent

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claim 37 and 52	binder
claim 37 and 52	this
claim 43, lines 4/5+6	the particle volume transfer valued d98
claim 58, line 9	this
claim 59, line 10	this
claim 59, line 11; claim 60, line 8; claim 61, line 8	the welding electrodes

e) Claim 33 and 48: the mixture already has a resin, so “additionally comprises at least one resin” is confusing. In addition, it is not clear what “optionally” in line 2 is modifying – curing agent or all the species that follow.

f) Claim 35 and 50: it is not clear what is meant by “ground separately” – separate from what?

g) Claim 37 and 52: “of at least one” does not make sense – one what?

h) Claims 41 and 56: should be put into proper Markush terminology – selected from the group consisting of.

i) Claim 42 and 57: it is not clear if this is the same pretreatment as in the independent claims.

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j) Claims 59-61: it is not clear what is meant by "can be set through two substrates coating in this manner". In addition, it is not clear if the action actually happens or is merely possible.

k) It is not clear if the following actually occurs or is merely possible:

claim 26, line 2	can be shaped
claim 27, line 2	can be shaped
claim 27, line 3	it being possible
claim 31	capable of
claim 34	capable of
claim 46	capable of
claim 49	capable of
claims 58-61, line 2 of each	can be shaped
claim 62 and 64	can be shaped

l) Claims 58-62, 64: coating should not be claimed in the absence of a substrate. Coating is associated with the thing coated. See Ex parte Scott 66 USPQ 371.

m) Claim 64: one of claim 27 does not make sense.

n) Claims 26-28 and 43 contain the trademark/trade name "Mastersizer 2000 with a Hydro 2000S head". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35

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U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a piece of apparatus to measure particle size and, accordingly, the identification/description is indefinite.

o) Claims 58-61: these coatings are referred to as “polymeric”, but do not contain any polymers or resins.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 58-65 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a composition that comprises a resin, does not reasonably provide enablement for a composition that lacks a resin. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

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5. Claims 58-65 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a composition that comprises inorganic particles that either have the transfer value d99 of claim 26 or the particle size distribution of claim 27, does not reasonably provide enablement for a composition comprising particles that do not meet these specifications. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

6. Claims 58-65 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a composition that would result in some of the inorganic particles projecting from an applied dried coating, does not reasonably provide enablement for that does not have particles projecting from the applied dried coating. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

7. Claims 26-65 rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The identity of particles with Mohs hardness greater than 4 and the identity of particles with Mohs hardness greater than 5.5, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

See Page 38 lines 19-29 and the tables: it is not clear what particles in the composition have the Mohs>4 and which have the Mohs> 5.5. Thus the disclosure is not enabling.

8. Claims 58-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following is not in the specification as filed:

- a) Claim 58: “abrasion only of less than 2 g per m²”
- b) Claim 59: “thickness of at least 4 um and less than 10 um”
- c) Claim 60: “thickness of at least 4 um and less than 10 um”
- d) Claim 61: “thickness of at least 4 um and less than 10 um”

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 58-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (5001173).

‘173 teaches applying an epoxy resin composition containing zinc and / or ferro alloys to steel or galvanized metals to provide a weldable coating. The coating composition appears to meet or overlap the parameters of claims 58-65, including Mohs hardness, weldability, thickness and cure temperature (11:28-21:32).

11. Claims 58-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moyle et al (5260120).

‘120 teaches coating steel or zinc coated steel with a composition that preserves a welding electrode. The coating contains ferrophosphorus and zinc powders.

The coating composition appears to meet or overlap the parameters of claims 58-65, including Mohs hardness, weldability, thickness and cure temperature (see Abstract, 2:19-3:3).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/
Primary Examiner
Art Unit 1792

February 8, 2008